



Docket No. 12969-1

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

5 Applicant: Bitler et al

Group Art Unit: 1714

Serial No.: 09/810,920

Examiner: Peter Szekely

Filing Date: March 16, 2001

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Title: Polymeric Thickeners for Oil-containing Compositions

Assistant Commissioner for Patents

Washington, DC 20231

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**REPLY**

**INTRODUCTORY COMMENTS**

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This paper is a reply to the Office Action mailed March 31, 2003. Reexamination, reconsideration and allowance are respectfully requested in view of the Amendments and Remarks below. This reply has been prepared in accordance with the recently promulgated Revised Amendment Format.

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**Telephone Interview**

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A brief telephone interview took place on June 12, 2003, between the Examiner and the undersigned. Before the interview, the Examiner had been provided with a draft Reply. During the interview, the Examiner indicated that after amendment in the way proposed in the draft Reply and the filing of a terminal disclaimer, the previously rejected claims containing numerical ranges for the amount of the thickening agent

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On June 17 2003 Typed name of person signing this certificate: T. H. P. Richardson

Signature

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would be allowable, but that the rejected claims specifying that the thickening agent is present in amount sufficient to thicken the composition would not be allowable. Applicant is not willing to limit the rejected claims to those containing numerical ranges.

5           The undersigned did not clearly understand other positions taken by the Examiner during the interview. Insofar as the undersigned was able to understand those positions, they appeared to be as follows.

10           (1)    The Examiner had earlier withdrawn his objection that it was new matter to state that the thickening agent was "present in amount sufficient to thicken the oil" because of the disclosure in Morawsky U.S. Patent No. 5,736,125, which was incorporated by reference in this application.

15           (2)    In view of (1) above, and because Morawsky discloses a range of 0.1 to 12% for the amount of the thickening agent, the Examiner construes the claims specifying that the thickening agent is present in amount sufficient to thicken the oil as being limited to the use of 0.1 to 12 % of the thickening agent.

20           (3)    Because Morawsky provided the basis for the requirement in some of the rejected claims that the thickening agent was present in amount sufficient to thicken the composition, it is clear that Morawsky is relevant to the rejection of those claims under 35 U.S.C. 102 and 103.

25           The amendments requested in the present Reply are the same as those requested in that draft Reply, with the following exceptions.

30           1.    Claims 62 and 63 have been added. These claims are dependent on claims 1 and 20 respectively, and specify that the amount of the SCC polymer is 0.1 to 12 % by weight (i.e. the preferred range of concentration disclosed in Morawsky U.S. Patent No. 5,736,125).

35           2.    The requested amendment to the paragraph on page 10, lines 14-18, now refers to the amount of the polymeric thickener being sufficient to thicken the composition to the desired thickness, for example 0.1 to 12% by weight of the oil. This amendment reflects the disclosure on page 3, lines 19-22 of Morawsky U.S. Patent No. 5,736,125.

The arguments presented in the present Reply are similar to those presented in the draft Reply, but have been amended and amplified as to the issues which appear, from the telephone interview, to be most important to the outstanding rejections.

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### **Construction of Rejected Claims, and Petition**

Applicants believe that it is important that the record should be clear as to the meaning of the claims requiring that the thickening agent is present "in amount such that it thickens the oil". If paragraph (2) above, summarizing statements made by the Examiner during the interview, is correct, there is a fundamental difference between the Examiner's and the Applicant's constructions of those claims. As explained previously, and again in the attached Petition, Applicant believes that the claims in question cover the use of any amount of thickening agent which will in fact thicken the oil, i.e. the use of amounts which may be outside the range of 0.1 to 12%. If the Examiner, after consideration of this Reply and the attached Petition, agrees that the claims in question cover the use of any amount of thickening agent which will in fact thicken the oil, i.e. the use of amounts which may be outside the range of 0.1 to 12%, he is asked to state that agreement on the record. If, however, the Examiner is not prepared to state such agreement on the record, he is asked to forward the attached Petition to the Petitions Branch.

**Basis for the limitation that the thickening agent is present in amount such that it thickens the oil.**

As noted in paragraph (2) above, in the telephone interview, the Examiner stated (insofar as the undersigned was able to understand what the Examiner said) that he had had earlier withdrawn his objection, that it was new matter to require that the thickening agent was "present in amount sufficient to thicken the oil", because of the disclosure in Morawsky U.S. Patent No. 5,736,125, which is incorporated by reference

in this application. Applicant believes that the proper construction of the claims in question is not dependent on the Examiner's rationale for withdrawing the objection. However, in case the Examiner thinks otherwise, the following points are noted.

- 5           1.       Paragraphs 1 and 2, on pages 19-28 of the Reply mailed January 27, 2003 set out in detail Applicants' reasons for believing that the requirement in question did not involve new subject matter or result in the claims which should be rejected for lack of enablement. One of the reasons was the incorporation by reference of Morawsky U.S. Patent No. 5, 736,125. The majority of the reasons
- 10           focused on other relevant disclosure in the specification as filed.
2.       Applicant believes that, even in the absence of the incorporation by reference of Morawsky, no new subject matter is involved in the requirement that the thickening agent should be present in amount sufficient to thicken the oil.